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#### REMARKS

This Amendment is submitted in response to the Office Action mailed on March 20, 2007. Claims 39 - 47 are pending, and all stand rejected at present.

A REPLACEMENT SHEET for Figure 14 is herewith enclosed.

#### RESPONSE TO 112 - REJECTIONS OF CLAIMS - PART 1

##### Claim 44

Claim 44 was rejected, on the grounds that it is impossible that the "peripheral device" take the form of a "display." Applicant points out that a "peripheral device" is defined as a non-essential part of the actual computation components of a computer. The computation components include (1) the processor(s), (2) memory, (3) data busses, etc. "Peripheral devices" include input-output devices.

A "display" is an output device, and can also be an input device, as in a touch-screen display. It is a "peripheral device."

Further, the Specification, page 5, line 21 et seq., states that a print request is an example of the claimed "request." It is common knowledge that a print request can be re-directed to a display, wherein the subject matter of the print request is "printed" on a display screen.

Further still, the Specification, page 16, lines 6 - 17,

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expressly states that the "appropriate peripheral" is commanded to fulfill the "request," and that display 52 is a "peripheral." The Specification, page 9, lines 22 - 24 also states that display 52 is a "peripheral."

Still further, the Office Action has not given any evidence as to why the claimed operation is impossible. Why is it impossible for the remote third party application to request that a message be printed on a video display ?

Evidence is required. A naked conclusion is insufficient.

In this connection, Applicant points out that the Office Action is, in effect, asserting that the Specification is non-enabling. MPEP § 2164.04 states:

#### BURDEN ON THE EXAMINER UNDER THE ENABLEMENT REQUIREMENT

. . . [T]he Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention.

. . .

[The] Specification . . . must be taken as being in compliance with the enablement requirement . . . unless there is a reason to doubt the objective truth of the statements contained therein . . .

. . .

[It] is incumbent upon the Patent Office . . . to explain why it doubts the truth or accuracy of any statement in a supporting disclosure . . .

. . .

[T]he minimal requirement is for the Examiner to give reasons for the uncertainty of the enablement. This standard is applicable even when there is no evidence in the record of operability without undue experimentation beyond the disclosed embodiments.

#### **Claim 46**

As to the rejection of claim 46, Applicant points out that the Specification, page 9, lines 23 and 24, refers to a "touchscreen module 54 mounted onto the display 52." A touchscreen display is an input-output device, which accepts user input.

#### **Claims 39 - 47**

As to the rejection of claim 39 - 47, Applicant points out that the Office Action must contain typographical errors, because the paragraph bridging pages 6 and 7 appears to make no sense.

Specifically, the second sentence, beginning with "Usage of user input . . ." and ending with ". . . not enabled by the disclosure," is not written in grammatically correct English, and thus cannot be understood.

Further, this paragraph appears to state that something, which is not claimed, is not enabled by the Specification. Applicant points out that he has no obligation to provide

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enablement for non-claimed subject matter.

And if he did, a totally absurd situation would exist. Since most of the universe is **NOT** claimed in every patent application, if Applicants were required to show enablement for that most-of-the-universe (ie, the unclaimed stuff), then no Applicants at all could ever fulfill the requirement.

Applicant requests that, if the PTO wishes to persist in this rejection, that a statement of the objection be made in correct, understandable English.

In addition, as to the supposed missing critical limitation, Applicant points out that MPEP § 2164.08(c) states:

. . . an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when **the language of the specification makes it clear** that the limitation is critical for the invention to function as intended.

Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality.

Applicant thus requests that the "language of the specification" mentioned in this MPEP section be identified.

#### **RESPONSE TO 112 - REJECTIONS OF CLAIMS - PART 2**

In response to the rejections in section 7, beginning on page 7 of the Office Action, Applicant points out the following.

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**re: Control by Third Party**

The Office Action asserts that "the peripheral device has to perform according to the instructions" of the third party. Even if this statement is true, it is misleading.

As to whether the statement is true, Applicant points out that if the third party is not an authorized, or approved, third party, it makes no difference what "instructions" that third party issues. Those "instructions" will not be executed.

Therefore, it is incorrect to state that "the peripheral device **HAS TO PERFORM** according to the instructions."

The "instructions" are only performed if they are authorized.

As to being misleading, if the instructions are authorized, it is the agency which (1) performs the authorization and (2) delivers the instructions which actually causes the instructions to be performed.

Therefore, Applicant submits that the Office Action's assertion is incorrect, for at least the two reasons just given.

**re: Limited Use by Third Party**

The sentence on page 7, beginning with "The claimed invention fails . . ." and ending with ". . . during the use of the peripheral device" is not written in grammatically correct

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English, and cannot be understood.

Further, this sentence appears to assert that some limitation is required to be added to the claims, but fails to (1) state what that limitation is and (2) fails to give a reason for the requirement.

Applicant cannot be expected to guess at the PTO's intentions. The proposed limitation must be set forth. And a reason is required.

**re: Absence of Third Party**

The claims have been amended to recite a "remote" third party.

However, this amendment is seen as non-necessary. Under ordinary English usage, a "third party" is a party **different** from the parties under discussion. That is, parties A and B may make a deal. Party C would be a "third party."

In the present case, party A is the customer, party B is the ATM (or its owner). A "third party" cannot be the ATM (or its owner), because the customer is dealing with that party.

Therefore, the amendment is seen as redundant.

**re: First Full Paragraph on Page 8**

The claims now state that the "third party application" is "remote." Thus, it cannot reside within the claimed terminal,

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with which the customer interacts.

Further, as to the objection, the Office Action is merely asserting that the "third party application" can be viewed as residing within the SST. Even if that is true, what is the problem ? That would not make the claim indefinite under section 112. It may cause the claim to read on the prior art, but that is not a 112-issue.

**re: "Thereby"**

The word "thereby" in the claims sets forth a result which is attained through operation of previously recited elements. That is a limitation.

Further, even if "thereby" is treated as non-limiting, that only makes the claim broader. That is not a basis for a 112-rejection. That would merely mean that the claim contains language which is non limiting.

**re: Paragraph Bridging Pages 8 and 9**

This rejection has been addressed above.

An analogy is appropriate.

Assume that you own a safe deposit box at a bank. When you visit the bank, you (1) prove your identity, (2) request the box, and (3) perhaps present the key to the box. A bank clerk then retrieves the box, and gives it to you.

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One could say that you "instructed" the bank clerk to retrieve the box.

But retrieval occurs **only if** you prove that you are authorized to retrieve the box. And you do not perform the retrieval (ie, you do not control the retrieval process).

Further, if you prove authorization, the retrieval is done **on your behalf**. You, yourself, do not actually retrieve the box.

This analogy applies to the rejection. The third party application is analogous to the box owner. The SST (or applications therein) are analogous to the bank clerk.

The SST performs actions **for the third party application**, if the latter is authorized.

That does not mean that the third party application gains control of the SST.

Stated more simply, the mere fact that an event occurs, after the third party requests it, does not mean that the third party "controls" the execution of the event. That is a post hoc, ergo propter hoc argument. ("After that, therefore because of that.")

**re: Second and Third Full Paragraphs, Page 9**

The claims have been amended.



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**re: Paragraph Bridging Pages 9 and 10**

The claim has been amended.

**re: First Full Paragraph, Page 10**

There is nothing wrong with a relative term. For example, saying that "weight A" is "heavier" than "weight B" is a relative statement. But there is nothing wrong with that. That states a **clear relationship** between A and B.

The same principle applies to the claimed term "different."

The issue is **indefiniteness**, not relativity.

**re: Second Full Paragraph, page 10**

The claims have been amended. And the discussion of "third party" above resolves the issue.

**RESPONSE TO OBJECTION TO DRAWINGS**

A REPLACEMENT SHEET for Figure 14 is herewith submitted. However, Applicant makes the following Points, which emphasize that the agencies indicated in the Figure as performing certain tasks are illustrative only, and not limiting.

**Point 1**

A "user input device" which is "controlled by the terminal application" is found, for example, in element 54, Figure 3.

Applicant points out that Figure 14 is a flow chart of procedures, not hardware. Hardware is shown in Figure 3.

#### Point 2

It appears that many of the assertions are based on a misunderstanding of digital circuits.

For example, the Office Action asks, "Which **application** supports the exercising of the option ?" Applicant points out that, on the world of computer software and hardware, there is no necessity that a specific "application" respond to the "option."

For example, several buttons can be placed on the ATM, each representing a different option.

- Each can actuate a **different** program.
- Each can actuate a **different sub-routine** of a **single** program.
- Or maybe no "application" (ie, program) is involved at all. Maybe each button is connected to hard-wired logic (which is not considered a program).

Therefore, Applicant submits that the questions which the PTO is asking relate to specific implementational details, which are not the focus of the basic invention, and which are not being claimed.

**RESPONSE TO 101 - REJECTION**

Applicant points out that the method claims recite actuation of a device (ie, a machine). The actuation occurs in response to certain events.

Applicant requests a citation of authority in support of the PTO's 101-rejection, in view of the following facts.

FACT 1. A claim to a fire alarm, which detects fire and actuates a bell, appears to be patentable.

How is the present invention different, as characterized by the PTO ? The PTO states that the invention merely actuates a device, and Applicant points out that the actuation occurs if certain conditions exist. How is that different from the (patentable) fire alarm ?

FACT 2. The question is whether the invention is new, useful, and non-obvious (if novel). The Office Action is, in effect, arguing that the invention is non-useful (because novelty is addressed elsewhere, and thus non-obviousness is not relevant).

But the Specification clearly shows uses to which the invention can be put. It can be used in an ATM system, wherein a customer can obtain printed matter from a web site, without giving control of the ATM to the web site.

This applies to all other objections made in section 5, page 5, of the Office Action.

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In summary: the Office Action is applying the wrong tests.  
The actual question is whether the invention is

- 1) novel,
- 2) useful (ie, has a use) and
- 3) non-obvious (if novel).

Item (2) is the only one in question at present.

But the Specification clearly points out uses for the invention.

The Office Action raises several non-relevant assertions. For example, the assertion that "activating itself does not provide service to the user" is simply not relevant. The mere fact that a particular party chosen by the PTO is not benefitted by the use is not dispositive.

The question is whether a patentable use is present, not whether the PTO can find a party who does not benefit from that use.

This applies to all assertions in this section of the Office Action.

#### **RESPONSE TO OBJECTION TO NEW MATTER**

As to "SST presents" in the Office Action, page 2, section 3a, support for that phrase is found in the Specification at the following locations:

page 4, lines 24 - 26;

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page 11, lines 22, 23;

page 5, lines 10 - 20.

As to "permission from the SST", support is found at page 17, lines 20 - 25.

As to "an application at the SST," "is actuated," "an application in" and "the service requested," support is found on page 16, lines 1 - 22.

The remainder of this section argues that the stated operation is impossible, on the grounds that, if the peripheral operates as the third party application requested, then "control" of the peripheral was given to the third party application.

However, as explained herein, that is not necessarily so. For example, if you instruct a Coke machine to dispense a Coke, but do not insert proper money, you will not obtain a Coke.

But even if you do insert the proper money, you do not "control" the Coke machine. In fact, one could say that the Coke machine controlled you: it required you to insert money, to obtain a Coke.

Applicant points out that the Office Action cannot be understood. It appears to object to the underlined phrases, on the grounds that they are "new matter." Then, it demands that those phrases be removed.

But if that is done, then the text containing the phrases will make no sense.

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Further, this argument on impossibility is actually an enablement argument, not a new matter issue.

### RESPONSE TO 102 - REJECTIONS, PART 1

Claims 39 - 47 were rejected on grounds of anticipation, based on Ramachandran, who has Diebold as Assignee (abbreviated R-D herein).

#### Claim 39

##### Point 1

Claim 39 recites receiving a request from a **remote** third party application. Almost all of column 7 of R-D is cited to show this request.

However, column 7 merely discusses data stored remotely from an ATM, Automated Teller Machine. That data includes

- 1) data which serves to identify customers, such as passwords (column 7, lines 1 - 7),
- 2) audio and video instructions to be given to customers (column 7, lines 20 - 31),
- 3) financial data about customers' accounts (column 7, lines 8 - 19), and
- 4) advertising-type data (column 7, line 33 et seq.)

None of that shows "receiving a request from the third party

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application to use one of the peripheral devices of the self-service terminal" as claimed.

Point 2

The claim states that the "request" is in response to a user's accessing the remote third party application.

The Office Action asserts that this accessing of the third party application is shown at two locations.

LOCATION 1

The first location is column 2, lines 19 - 59. However, that location contains (1) objects of the R-D invention and (2) before the objects, two stated purposes of the R-D invention.

As to (2), the two stated purposes are to (A) increase security and (B) marketing products to users. Neither of those show accessing a remote third party application by the customer, as claimed.

As to (1), the objects of the R-D invention are listed at column 2, lines 29 - 59. The objects are to provide a financial terminal which

- identifies customers;
- gives instructions to customers;
- gives advertising to customers;
- selectively gives advertising to

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customers;  
-- gives multi-media presentations to  
customers; and  
-- dispenses items other than cash.

Clearly, no accessing of a remote third-party application by a customer is shown.

#### LOCATION 2

The second location is column 4, line 60 - column 5, line 14. However, that passage merely describes a generic ATM.

Clearly, no accessing of a remote third-party application by a customer is shown.

Thus, as so far discussed, two claim recitations are absent from the R-D reference.

#### Point 3

The claim states that a "peripheral" is activated to perform the request, without control of the peripheral passing to the third party application.

The Office Action cites column 14, line 38 - column 15, line 46 of R-D to show this.

However, this passage shows nothing of the kind.

-- It states that a "thank you message" is displayed.



- It states that customers can review their transaction, and collect items dispensed.
- It describes events which occur in the terminal if the customer leaves.
- It states that instructions can be given in different ways, to different customers, such to deaf persons.
- It states that different advertising can be given to different customers.

Therefore, the claim recitation has not been shown in R-D.

#### Conclusion

Three claim recitations are absent from the R-D reference.  
The claim states that

- 1) a customer, at a terminal (SST), accesses a remote third party application,
- 2) the third party application makes a "request" to use a peripheral device of the SST, and
- 3) the request is performed, without granting control of the peripheral to the third party application.

As just explained, none of these three recitations are shown in the R-D reference.

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MPEP § 2131 states:

A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

In addition, the claim states that a determination is made at the SST as to whether the request should be granted. That has not been shown in the reference.

#### **Remaining Independent Claims**

The discussion above applies to the remaining independent claims.

#### **Dependent Claims**

The dependent claims are seen as patentable, based on their parents.

#### **RESPONSE TO 102 - REJECTIONS, PART 2**

Claims 39 - 47 were rejected on grounds of anticipation, based on DeLeo.

#### **Claim 39**

As explained above, claim 39 states that

- 1) a customer, at a terminal (SST), accesses

- a remote third party application,
- 2) the third party application makes a "request" to use a peripheral device of the SST,
- 3) a determination is made on whether to perform the request, and
- 4) the request is performed, without granting control of the peripheral to the third party application.

Point 1

To show the accessing of the remote third party application, the Office Action cites column 3, lines 2 - 48. However, that merely discusses an ordinary ATM. No remote third party application is shown.

Point 2

To show the "request" from the third party application, the Office Action cites column 4, lines 8 - 51. However, that passage only discusses communication between a host 12 and stations 14. No "request" is mentioned.

Point 3

To show the determination of whether to grant the request,

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the Office Action cites column 7, lines 31 - 64. However, that passage discusses determining whether a "transaction request" by the ATM should be granted. (Column 7, lines 19, 20.)

That is the wrong request. It does not correspond to the claimed request. The claimed request is made by the remote third party application which the customer accessed. The request in DeLeo is made by the ATM.

And the wrong agency is making any determination as to that request. The claim states that the "terminal application" makes the determination. In DeLeo, the request is made by the ATM. Thus, no "terminal application" within the ATM makes the determination, as claimed. Some remote server does, contrary to the claim.

#### Point 4

To show performance of the request without granting control, the Office Action cites column 8, lines 5 - 58. However, nowhere does that passage discuss processing the claimed request. And, as stated above, the claimed request has not been shown in DeLeo, so the claimed processing is not shown either, let alone processing without passing control.

#### Conclusion

At least four claim recitations are absent from the DeLeo

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reference. Any one of those absences is fatal to the 102 -  
rejection.

#### **Remaining Independent Claims**

The discussion above applies to the remaining independent  
claims.

#### **Dependent Claims**

The dependent claims are seen as patentable, based on their  
parents.

#### **RESPONSE TO 102 - REJECTIONS, PART 3**

Claims 39 - 47 were rejected under section 102, based on  
Drummond.

#### **Claim 39**

As explained above, claim 39 states that

- 1) a customer, at a terminal (SST), accesses  
a remote third party application,
- 2) the third party application makes a  
"request" to use a peripheral device of the  
SST,
- 3) a determination is made on whether to  
perform the request, and

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4) the request is performed, without  
granting control of the peripheral to the  
third party application.

#### Overview of Drummond

The rejection relies on paragraphs 55 - 66 of Drummond.

#### Point 1

To show the accessing of the remote third party application,  
the Office Action cites paragraphs 55 - 59.

However, those paragraphs state

-- what ordinary ATMs do,  
-- that Drummond's invention does something  
in addition.

However, no accessing of a remote third party application by a  
customer is shown.

#### Point 2

To show the "request" from the third party application, the  
Office Action cites paragraphs 58 - 60.

These paragraphs may mention instructions sent to an ATM  
which, for example, order the ATM to perform printing.

But they do not state that the instructions are done by a  
remote third party application which was accessed by the

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customer.

#### Point 3

To show the determination of whether to grant the request, the Office Action cites paragraphs 61 - 63.

However, those paragraphs do not discuss the request claimed. The claimed request is from a remote third party application which the customer accessed. That is not shown in these paragraphs.

#### Point 4

To show performance of the request without granting control, the Office Action cites paragraphs 64 - 66.

However, those paragraphs, taken with the other paragraphs cited, indicate that some remote application can unilaterally issue a command to a peripheral, such as a printer, at an ATM. That is contrary to the claimed recitation of the SST making a determination of whether to grant the request.

#### Conclusion

At least four claim recitations are absent from the Drummond reference. Any one of those absences is fatal to the 102 - rejection.

Request

Applicant requests, under 37 CFR §§ 1.104(c)(2) and 35 U.S.C. § 132, that the PTO specifically identify in Drummond these claim elements:

- 1) The remote third party application,
- 2) The "service,"
- 3) The "request,"
- 4) The "peripheral device" which is  
"activated," and
- 5) The determination of whether the  
"request" should be granted.

**Remaining Independent Claims**

The discussion above applies to the remaining independent claims.

**Dependent Claims**

The dependent claims are seen as patentable, based on their parents.



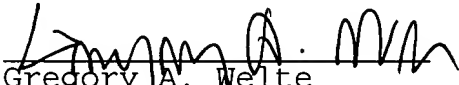
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**CONCLUSION**

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,

  
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